



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/000,824	12/30/1997	JAYANTHA AMARASEKERA	60SI-1890	5842

7590 12/01/2004

Robert M. Schulman
Hunton & Williams
1900 K Street, N.W
Suite 1200
Washington, DC 20006-1109

EXAMINER

LU, C CAIXIA

ART UNIT PAPER NUMBER

1713

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/000,824

Applicant(s)

AMARASEKERA ET AL.

Examiner

Caixia Lu

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19-24 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19-24 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 17, 19-24 are rejected under 35 U.S.C. 112, first paragraph for the same rationale as set forth in the previous Office action mailed on July 14, 2004, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 102

2. Claims 1-6, 8-13, 17, 19-24 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsushita et al. (US 5,824,729) for the same rationale as set forth in the previous Office action mailed on July 14, 2004.

Claim Rejections - 35 USC § 103

3. Claims 7,12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsushita et al. (US 5,824,729) for the same rationale as set forth in the previous Office action mailed on July 14, 2004.

4. Claims 1-17, 19-24 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dams (US 4,355,129) in view of Milbert (US 3,821,140) for the same rationale as set forth in the previous Office action mailed on July 14, 2004.

Response to Arguments

5. Applicants' arguments filed October 15, 2004 have been fully considered, the rejection under 35 U.S.C. 112, second paragraph is withdrawn in view of

Art Unit: 1713

applicants amendment, however, the rest of rejections of the record are maintained.

(i) Response to applicant's argument over the rejections under 35 U.S.C. 112, first paragraph.

(A) Applicants assert that "[t]he claimed peroxide range is expressly disclosed" and point out that support can be found on page 3 lines 12-13 and page 4 lines 22-22, and applicants argue that "[t]he use of the expression 'weight parts' of the claimed peroxide range is entirely consistent with the disclosure in the specification of 'weight percent' for the range, as would be understood by a person skilled in the art". This is incorrect. While both wt.% and weight parts measure the relative amounts of each components in a composition, the definition of wt.% and weight part are different. For example, according a the disclosure on page 2 of the specification, if the weight part of the curing agent (peroxide) is 0.1 to 5, the corresponding weight parts of the silicone polymer should be 15 to 50. While those ranges overlap with those of the instant claims, they are by no chance to be the same as those ranges of the instant claims. Therefore, the entire claimed range of component (D) of claim 17 is not supported by the application as originally filed and, thus, new matter.

(B) Applicants assert that "[t]he formula of organopolysiloxane is implicitly and inherently disclosed", and applicants conclude that the context of formula I of page 3 and silicone used in the working example supports such assertion without providing any reasoning. On the contrary, Formula I with "n" in the range from 1,000 to 2,000 is a diorganosiloxane and has a compositional formula of $R_aSiO_{(4-n)}$.

Art Unit: 1713

a)₂ wherein, "a" has a value of 2.0 rather than the 1.95 to 2.05 of claim 17. Value "a" of formula I is calculated from $a = \{2.0 + 2.0/(n+1)\} = \{2.0 + 2.0/(1000 \sim 2000 + 1)\} = 2.002 \sim 2.001$, which round off to $a=2.0$. Therefore, the organopolysiloxane compositional formula of claim 17 is new matter.

(ii) Response to applicant's arguments over the rejection under 35 U.S.C. 103 over Dams in view of Milbert.

Applicants argue that Milbert and Dams are not properly combinable because Dams and Milbert are directed to entirely different purposes, Dams to silicon rubber with improved color retention when exposed to corona discharge and Milbert to a fire resistant elastomer. The examiner disagrees. Applicants' attentions are directed to Milbert's col. 4, lines 1-9 and Dams' col. 1 lines 8-19, both references teach those silicone compositions being used in as insulating sheaths for electrical conductors, such as cables. Therefore, Milbert and Dams are analogous because they both are from the same area of endeavor of silicone composition for insulating electrical conductors.

Applicants argue that the coupling agent is critical to the composition of the instant claims by cited the disclosure of pages 3-4 of the specification that by having a coupling agent, ATH and fumed silica are rendered hydrophobic and they interact with polysiloxanes this enhancing their dispersibility and reinforcing effect. However, those are known expected benefits of treating silica and ATH with the coupling agent at the time of the invention. Applicants's assertion that Milbert teaches away from the claimed range of coupling agent is merely conclusionary. As stated in the previous Office action, using coupling agent to

Art Unit: 1713

enhance the compatibility between the siloxane and the filler as well as ATH are will known routing practice in industry and coupling agents are taught in both Milbert and Dams. The reference does not disclose the specific amount coupling agent because the amount of the coupling agent needed is mainly depended on the amount of silica and ATH in the composition, can be easily determined thought routine experimentation, and such amount are commonly known at the time of the invention. In the previous Office action, the examiner has provided Imahashi (US 5,583,172) which teaches treating 100 parts by weight metal hydroxide surface with 0.1 to 10 parts by weight of coupling agent in lines 31-36 of col. 3 and the relative amount of coupling agent to the metal hydroxide encompasses that of the instant claims.

Applicants' statement of that all of the products prepared showed superior physical properties in specification does not meet the requirement for showing criticality and unexpected results for overcome the rejection over the cited reference. Applicants need to show how the claimed composition is superior over those of the cited prior art and the showing must commensurate with the scope of the claims.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caixia Lu whose telephone number is (571) 272-1106. The examiner can normally be reached from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful and the matter is urgent, the examiner's supervisor, David Wu, can be reached at (571) 272-1114. The fax numbers for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1700.



Caixia Lu, Ph. D.
Primary Examiner
November 27, 2004